



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 040425/0149

Applicant: Hidehiro MATSUMOTO

Title: INFORMATION COMMUNICATION SYSTEM, INFORMATION  
COMMUNICATION METHOD, AND INFORMATION  
PROVISION BUSINESS METHOD

Serial No.: 09/777,902

Filed: February 7, 2001

Examiner: Lastra, Daniel

Art Unit: 3622

**RECEIVED**

JAN 09 2004

**GROUP 3600**

**INFORMATION DISCLOSURE STATEMENT  
UNDER 37 CFR §1.56 and 37 CFR §1.97**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

Submitted herewith on Form PTO-SB08 is a list of documents known to Applicant in order to comply with Applicant's duty of disclosure pursuant to 37 CFR 1.56. A copy of each listed document is being submitted to comply with the provisions of 37 CFR 1.97 and 1.98.

The submission of any document herewith, which is not a statutory bar, is not intended as an admission that such document constitutes prior art against the claims of the present application or that such document is considered material to patentability as defined in 37 CFR §1.56(b). Applicant does not waive any rights to take any action which would be appropriate to antedate or otherwise remove as a competent reference any documents which is determined to be a prima facie prior art reference against the claims of the present application.

**TIMING OF THE DISCLOSURE**

The instant Information Disclosure Statement is being filed after the mailing date of a first Office action on the merits, but before the mailing date of a final Office Action or a notice of allowance. Accordingly, a certification or fee is required. A certification is provided below.

**CERTIFICATION**

The undersigned hereby certifies in accordance with 37 C.F.R. §1.97(e)(1) that each item of information submitted with this Information Disclosure Statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three (3) months prior to the filing of this Statement.

**RELEVANCE OF EACH DOCUMENT**

A translation of a portion of a Japanese Office Action that issued October 14, 2003 with respect to a counterpart Japanese patent application is provided below.

"Claims: 1 through 25  
Cited Literature: 1 and 2

**Remarks**

Cited Literature 1 discloses an invention wherein, when a user, using a street terminal connected via telecommunication lines, obtains desired information from among information provided by participating businesses, said user's personal information (name, address, age, sex, etc.) and information on the course of operations performed at the street terminal in question (date and time, location, screens used, downloaded file names, etc.) is transferred via telecommunication lines to a server computer, and the server computer tabulates and analyzes the transferred information, thereby making it possible to provide analysis results necessary for marketing research to the participating businesses.

Moreover, whether the information transferred from the street terminals to the server computer is to be stored in a single database, or if personal information and information on the course

of operations are to be stored separately and with encryption, is found to be a feature which could be suitably modified by a system designer from the viewpoint of protecting personal information.

While the invention described in Cited Literature 1 uses street terminals, applying it to portable terminals is found to entail no particular technical difficulty for a person skilled in the art.

Furthermore, filtering the information provided based on a user's profile is not found to be remarkable in the technical field in question, as disclosed in Cited Literature 2.

With respect to consent for disclosure of profile information and preference information involved in the invention of the present application, this is something based upon agreement between the parties concerned, and this point is not recognized as a technical feature.

Therefore, it is found that the invention of the present application could be easily achieved by a person skilled in the art based on the inventions described in Cited Literature 1 and 2.

If any reasons for rejection are newly discovered, a notice of reasons for rejection will be issued.

#### List of Cited Literature

1. Japanese Unexamined Patent Application Publication H11-110352 [handwritten: Cited
2. Japanese Unexamined Patent Application Publication H9-245049 references (Relevant)."

Applicant's statements regarding the Japanese Office Action are based on a partial translation that Applicant's representative obtained. These statements should in no way be considered as an agreement by Applicant with, or an admission of, what is asserted in the Japanese Office Action.

Applicant respectfully request that the listed documents be considered by the Examiner and formally be made of record in the present application and that an initialed copy of Form PTO/SB/08 be returned in accordance with MPEP §609.

Respectfully submitted,

December 31, 2003  
Date

Phillip J. Articola  
Phillip J. Articola  
Registration No. 38,819

FOLEY & LARDNER  
Washington Harbour  
3000 K Street, N.W., Suite 500  
Washington, D.C. 20007-5143  
Telephone: (202) 672-5300  
Facsimile: (202) 672-5399